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PATENT
930024-2001



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

AF#
3728
#32
Brief
E. J. Zanco
5/16/02

Applicant(s) : Alain Zanco
Serial No. : 09/172,830
For : **BOOT FOR SKI OR IN-LINE ROLLER SKATE**
Filed : October 15, 1998
Examiner : J. Kavanaugh
Art Unit : 3728

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APPEAL BRIEF OF APPELLANTS

Board of Patent Appeals and Interferences
Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This is an Appeal from the Final Rejection by the Examiner dated November 29, 2001, which issued in the above-identified application, finally rejecting claims 1-3, 5, 8 and 9. A Notice of Appeal was filed on March 29, 2002 (received by the USPTO on April 8, 2002). As this paper is being submitted within the two-month term for reply set by the date of filing of the

Notice of Appeal, no fee is believed to be due. A check in the amount of \$320.00 is attached in payment of the required fee set forth in 37 CFR 1.17 (c). This Brief is submitted in triplicate as required by 37 C.F.R. §1.192(a) and the Assistant Commissioner is authorized to charge the requisite fee set forth in 37 C.F.R. §1.17(f) or charge any deficiency or credit any overpayment to Deposit Account No. 50-0320.

RELIEF REQUESTED

It is respectfully requested that the rejection of claims 1-3, 5, 8 and 9 be reconsidered and withdrawn, and that a Notice of Allowance promptly issue.

REAL PARTY IN INTEREST

The real party in interest is Skis Rossignol, a French company, with offices at: S.A., Voirin, France, to which Appellants have assigned all interest in this application.

RELATED APPEALS AND INTERFERENCES

Upon information and belief, the undersigned attorney does not believe that there is any appeal or interference that will directly affect, be directly affected by or have a bearing on the Board's decision in the pending appeal.

REQUEST FOR AN ORAL HEARING

An oral hearing is requested.

STATUS OF THE CLAIMS

The Application was filed with claims 1-11 on October 15, 1998 and assigned Application Serial No. 09/172,830.

In a first Office Action dated July 7, 1999, the Applicant was required to elect a species under 35 U.S.C. 121.

In response to the first Office Action, elected the species described in Figures 1, 3 and 4 as revealed in claims 1-6 and 8-9 on July 23, 1999.

In a second Office Action dated July 30, 1999, the Examiner withdrew claims 7, 10 and 11 and rejected claims 1-6, 8 and 9 under 35 U.S.C. § 112, second paragraph as allegedly indefinite. The Examiner additionally rejected claims 1-5, 8 and 9 under 35 U.S.C. § 102(e) as

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anticipated by Donnadiu (U.S. patent No. 5, 884,420 “hereafter referred to as “the ‘420 patent” and 5,899,006 “hereafter referred to as “the ‘006 patent”) and claim 6 under 35 U.S.C. § 103(a) as unpatentable over either Donnadiu (the ‘420 patent and the ‘006 patent) in view of Turner et al. (U.S. Patent No. 5, 505,477).

In response to this Second Office Action, Appellants filed an Amendment September 6, 1999 and canceling claim 6, amending claims 1-3, 5 and 8 to overcome the 112, second paragraph and 102(b) rejections; and also amended the specification to correct some minor errors.

The Examiner then issued a Final Office Action on January 12, 2001 maintaining the rejection of claims 1-5, 8 and 9 under 35 U.S.C. § 112, second paragraph and rejecting claims 1, 2, 8 and 9 under 35 U.S.C. § 102(e) as anticipated by Bourque (U.S. patent No. 4,674,202), claims 1-4 under 35 U.S.C. § 102(e) as anticipated by Gladek (U.S. patent No. 4,246,708), claims 1-4 as anticipated by Donnadiu (the ‘420 patent and the ‘006 patent), claims 5, 8 and 9 under 35 U.S.C. § 103(a) as unpatentable over either Donnadiu (the ‘420 patent or the ‘006 patent) or Gladek in view of Bourque (U.S. Patent No. 4,674,202) and Salzman (U.S. Patent No. 4,186,500) and claims 3-5 under 35 U.S.C. § 103(a) as unpatentable over either Bourque in view of Donnadiu or Gladek.

In response to the Final Office Action, Appellants filed an Amendment After Final on April 10, 2001 amending claims 1-3, 5 and 8 to overcome the 112, second paragraph, 102(b) and 103(a) rejections.

The Examiner then issued an Advisory Action on April 13, 2001 which indicated that the previous Amendment was not entered because the proposed claim amendments which appears to correct the indefinite language, changes the scope of the claims and raises new issues that require further consideration and search.

In response to the Advisory Action, Appellants filed a continued prosecution application (CPA) on May 3, 2001.

The Examiner then issued a Office communication (PTO-90C) on May 23, 2001 indicating the previous reply was not fully responsive to the January 12, 2001 Office Action.

In response to the Office communication, Appellants filed an Amendment in response to the PTO-90C notification of a non-fully responsive reply on July 9, 2001, cancelling claim 4 and amending claims 1, 3, 5 and 8 and the specification in response to the Examiner’s comments.

The Examiner then issued an Office Action dated July 12, 2001 rejecting claims 1-3, 5, 8 and 9 under 35 U.S.C. § 112, second paragraph and claims 1, 2, 8 and 9 under 35 U.S.C. § 102(e) as anticipated by Bourque (U.S. patent No. 4,674,202), claims 1-3 under 35 U.S.C. § 102(e) as anticipated by Gladek (U.S. patent No. 4,246,708), claims 1-3 as anticipated by Donnadiou (the '420 patent and the '006 patent), claims 5, 8 and 9 under 35 U.S.C. § 103(a) as unpatentable over either Donnadiou (the '420 patent or the '006 patent) or Gladek in view of Bourque (U.S. Patent No. 4,674,202) and Salzman (U.S. Patent No. 4,186,500), claims 3 and 5 under 35 U.S.C. § 103(a) as unpatentable over either Bourque in view of Donnadiou or Gladek and claims 1-3, 5, 8 and 9 under the judicially created doctrine of obvious-type double-patenting over claims of U.S. patent No. 6,173,510.

In response to the Office Action, Appellants filed an Amendment on November 7, 2001 amending claims 1-3, 5, 8 and 9 to overcome the 112, second paragraph, 102(b) and 103(a) rejections and Applicants requested deference of the obvious-type double-patenting rejection until the claims are found to be allowable.

The Examiner then issued a Final Office Action dated November 29, 2001 maintaining the rejection of claims 1-3, 5, 8 and 9 under 35 U.S.C. § 112, second paragraph, claims 1, 2, 8 under 35 U.S.C. § 102(e) as anticipated by Bourque (U.S. patent No. 4,674,202), claims 1-3 under 35 U.S.C. § 102(e) as anticipated by Gladek (U.S. patent No. 4,246,708), claims 1, 3 and 9 as anticipated by Donnadiou (the '420 patent and the '006 patent), claims 5 and 8 under 35 U.S.C. § 103(a) as unpatentable over either Donnadiou (the '420 patent or the '006 patent) or Gladek in view of Bourque (U.S. Patent No. 4,674,202) and Salzman (U.S. Patent No. 4,186,500), claims 3 and 5 under 35 U.S.C. § 103(a) as unpatentable over either Bourque in view of Donnadiou or Gladek and claims 1-3, 5, 8 and 9 under the judicially created doctrine of obvious-type double-patenting over claims of U.S. patent No. 6,173,510.

A Notice of Appeal and a request for one month extension of time was filed by Appellants on March 29, 2002, from which this Appeal Brief is being filed.

This Appeal Brief is being filed pursuant to the March 29, 2002 Notice of Appeal.

Accordingly, the status of the claims may be summarized as follows:

Claims Allowed: None.
Claims Objected to: None.
Claims Rejected: 1-3, 5, 8 and 9.

w/p claims 7, 10, 11

Final correct

STATUS OF THE AMENDMENTS

Appellants believe that all the submitted Amendments, except for the April 10, 2001 Amendment After Final Action, have been entered.

SUMMARY OF THE INVENTION

The present invention is directed to, *inter alia*, a boot for a ski or in-line roller skate, the boot having a sole with a heel portion and a front portion, the sole being connected to a flexible upper, wherein the sole has a first rigid part which extends forward from said heel portion over about one half of the length of the sole, wherein the sole has a flexible portion which extends from the front portion rearward to the first rigid part so as to allow the foot to flex during walking, and wherein the first rigid part includes an interlocking surface means which interlocks with a binding of an alpine ski or in-line roller skate thus firmly fixing the first rigid part against flexing with respect to the flexible portion.

ISSUES PRESENTED

1. Whether there is support in the specification for the term "interlocking surface means".
2. Whether the term "interlocking surface means" as recited in claim 1 is indefinite.
3. Whether claims 1, 2 and 8 are under 35 U.S.C. § 102(e) are anticipated by Bourque (U.S. patent No. 4,674,202), claims 1-3 under 35 U.S.C. § 102(e) are anticipated by Gladek (U.S. patent No. 4,246,708), claims 1-3 and 9 are anticipated by Donnadieu (U.S. Patent Nos. 5,884,420 and 5,899,006), claims 5 and 8 are unpatentable under 35 U.S.C. § 103(a) over either Donnadieu (the '420 patent or the '006 patent) or Gladek in view of Bourque (U.S. Patent No. 4,674,202) and Salzman (U.S. Patent No. 4,186,500), claims 3 and 5 are unpatentable under 35 U.S.C. § 103(a) over either Bourque in view of Donnadieu or Gladek.

GROUPING OF CLAIMS

For purposes of this appeal, claims 1-3, 5, 8 and 9 are to be considered.

ARGUMENTS

The Specification Was Improperly Objected To

The specification was objected to under 35 U.S.C. §1.75(d)(1) as allegedly failing to provide clear support or antecedent basis for the claim terminology. More particularly, the Examiner asserts that the term “interlocking surface means” does not appear in the specification. Appellants respectfully traverse this position.

Appellants respectfully disagree with the position of the Examiner. The specification does provide support for the term “interlocking surface means”. See Figures 7 and 8 and page 7, lines 14-20:

The rigid part 1 of the sole may have **other ski binding means** intended to engage with a ski or skate binding. In the embodiment which is represented in Figures 7 and 8, these binding means consist of two pairs of lateral pins 9 and 10 which are intended to engage in the notches of the binding and are capable of being **locked in** these notches.

Accordingly, Applicants request that the objection to the specification be withdrawn.

Claims 1-3, 5, 8 And 9 Were Improperly Rejected As Being Indefinite

Claims 1-3, 5, 8 and 9 were rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. Applicants disagree.

Contrary to the assertion of the Examiner, the term “interlocking surface means” has clear and definite meaning when read in light of the specification and the rest of the claim language. Further, the term is definite and encompasses subject matter which is adequately described in the specification including the drawings and claims as originally filed.

“A claim is definite if the scope of the subject matter embraced by a claim is clear and if the applicant has not otherwise indicated that he intends the claims to be of a different scope. In re Borkowski, 164 USPQ 642 (CCPA 1970). The “distinctly claim” requirement of 35 USC § 112, second paragraph, means that the claims must have a clear and definite meaning when construed in light of the complete patent document. Standard Oil Co. v. American Cyanamid Co., 227 USPQ 293 (Fed. Cir. 1985). The test of definiteness is whether one skilled in the art would understand the scope of the claim when read in light of the specification. Morton Int. Inc. v. Cardinal Chem. Co., 28 USPQ2d 1190 (Fed. Cir. 1993). The degree of precision necessary is a function of the subject matter claimed. Hybritech Inc. v. Monoclonal Antibodies, Inc., 231 USPQ 81, 94-95 (Fed. Cir. 1986). Indeed, the Federal Circuit noted in Hybritech that:

‘[I]f the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of

the invention, and if the language is as precise as the subject matter permits, the courts can demand no more' [and] the claims are clearly definite.

Id at 94 (citing to Shatterproof Glass Corp. v. Libbey Owens Ford Co., 225 USPQ 634,641 (Fed. Cir. 1985)) (emphasis added).

Applying the law to the instant facts, as the instant claims, read in light of the specification, apprise a skilled artisan of both the utilization and scope of the invention, and as the language is as precise as the subject matter permits, the instant claims are definite. A contrary conclusion, as posited by the Final Office Action, would not only be against public policy, but also impermissible as a matter of law. Hybritech, 231 USPQ at 95 ("As a matter of law, no court can demand more.').

Specifically, and for the reasons that follow, Applicants respectfully urge that the term "interlocking surface means" conveys a clear meaning to a practitioner in this art when the term is read in the context of the rest of the claim and in light of the specification. Moreover, Applicants urge that this language is precise in view of the nature of the claimed subject matter.

The term "interlocking surface means" is used in claim 1 to refer to the embodiment which is represented in Figures 7 and 8 as reiterated above. Specifically, the claim 1 states:

...wherein the sole has a flexible portion which extends from the front portion rearward to the first rigid part so as to allow the foot to flex during walking, and
wherein the first rigid part includes an interlocking surface means which interlocks with a binding of an alpine ski or in-line roller skate thus firmly fixing the first rigid part against flexing with respect to the flexible portion.

(Emphasis added).

From the context of this sentence, it is clear that the term "an interlocking surface means" refers to other ski binding means which is capable of being locked into the notches of the binding of the boot to a ski or skate.

In view of the foregoing, Applicants urge that the specification and claims clearly define.

Claims 1-3, 5, 8 and 9 Are Improperly Rejected as Unpatentable Under 35 U.S.C.

§102(e) and §103(a)

Claims 1, 2, 8 were rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Bourque (U.S. patent No. 4,674,202), claims 1-3 under 35 U.S.C. § 102(e) as allegedly anticipated by Gladek (U.S. patent No. 4,246,708), claims 1, 3 and 9 as allegedly anticipated by

Donnadieu (U.S. Patent Nos. 5,884,420 and 5,899,006), claims 5 and 8 under 35 U.S.C. § 103(a) as allegedly unpatentable over either Donnadieu (U.S. Patent Nos. 5,899,006 and 5,884,420) or Gladek in view of Bourque (U.S. Patent No. 4,674,202) and Salzman (U.S. Patent No. 4,186,500), claims 3 and 5 under 35 U.S.C. § 103(a) as allegedly unpatentable over either Bourque in view of Donnadieu or Gladek.

The Office Action alleges that since Bourque, Gladek, and Donnadieu ('006 or '420) all allegedly teach a boot having a structure as claimed and that these structural elements would be inherently capable of performing functions such as serving as the interlocking surface. Appellants disagree.

It is not enough for one to contend that the structural elements in the relied-upon references "inherently" speak to the instantly claimed invention. The references must disclose or suggest the properties for inherency to attach. According to *In re Rijckaert*, 9 F.3d 1531, 1957 (Fed. Cir. 1993), "such a retrospective view of inherency is not a substitute for some teaching or suggestion[.]" The Federal Circuit is clear that "'inherency...may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient [to establish inherency].'" *Continental Can Company v. Monsanto Company*, 948 F.2d 1264, 1269 (Fed. Cir. 1991), *citing to In re Oelrich*, 666 F.2d 578, 581-582 (C.C.P.A. 1981). Indeed, "before a reference can be found to disclose a feature by virtue of its inherency, one of ordinary skill in the art viewing the reference must understand that the unmentioned feature at issue is *necessarily* present in the reference." *SGS-Thomson Microelectronics, Inc. v. International Rectifier Corporation*, 31 F.3d 1177 (Fed. Cir. 1994) (emphasis in original). Applying the law to the instant facts, none of the documents cited in the Office Action inherently teach, disclose or suggest the Applicants' invention.

That is, none of the documents inherently teach, disclose or disclose, *inter alia*, a boot for a ski or in-line roller skate, the boot having a sole with a heel portion and a front portion, the sole being connected to a flexible upper, wherein the sole has a first rigid part which extends forward from said heel portion over about one half of the length of the sole, wherein the sole has a flexible portion which extends from the front portion rearward to the first rigid part so as to allow the foot to flex during walking, and wherein the first rigid part includes an interlocking surface means which interlocks with a binding of an alpine ski or in-line roller skate thus firmly fixing the first rigid part against flexing with respect to the flexible portion.

Thus, inherency cannot attach.

Consequently, reversal of the Section 102 rejections are believed to be in order and such action is respectfully requested.

The Office Action contends that it would be obvious to provide the boot of either Donnadiou or Gladek with a cutout portion (or a profile part) as taught by Bourque and Salzman to provide reinforcement to the sole of the boot and facilitate securing to a binding. The Office Action further contends that it would have been obvious to one of ordinary skill in the art to provide a boot as taught by Bourque with the sole having a rigid part enclosing the heel as taught by either Donnadiou or Gladek to prevent twisting in the rear part of the boot.

However, and contrary to the Examiner's conclusion neither of Donnadiou or Gladek or Bourque or Salzman, either alone or in combination teach or suggest the instant invention according to claim 1, i.e., a boot for a ski or in-line roller skate, the boot wherein the sole has a first rigid part which extends forward from said heel portion over about one half of the length of the sole and the first rigid part includes an interlocking surface means which interlocks with a binding of an alpine ski or in-line roller skate thus firmly fixing the first rigid part against flexing with respect to the flexible portion. Therefore, none of the cited references either alone or in combination teach or suggest the instant invention according to claim 1 let alone claims 3, 5 or 8.

It is well established that there must be some prior art teaching which would have provided the necessary incentive or motivation for modifying the teachings of Donnadiou, Gladek, Bourque and Salzman. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (B.P.A.I. 1993). Further, "obvious to try" is not the standard under 35 U.S.C. §103. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). Indeed, as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification." For a Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants' disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

In the present situation, Donnadiou, Gladek, Bourque and Salzman fail to provide the necessary incentive or motivation that would lead a skilled artisan to practice the present invention. That is, Donnadiou, Gladek, Bourque and Salzman do not disclose or suggest the boot for a ski or in-line roller skate with a interlocking surface means at the rear of the boot which interlocks with a binding of an alpine ski or in-line roller skate as instantly claimed.

Consequently, a reversal of the Section 103(a) rejection is believed to be in order and such action is respectfully requested.

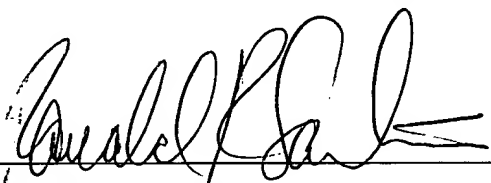
CONCLUSION

For the reasons discussed in this brief and the arguments of record (incorporated herein by reference), claims 1-3, 5, 8 and 9 are patentable over Donnadieu, Gladek, Bourque and Salzman. It is, therefore, respectfully submitted that the Examiner erred in rejecting claims 1-3, 5, 8 and 9 and a reversal of the rejection of claims 1-3, 5, 8 and 9 by this Honorable Board, and prompt issuance of a Notice of Allowance, are earnestly solicited.

Respectfully submitted,

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APPENDIX
CLAIMS ON APPEAL

1. (Amended) A boot for a ski or in-line roller skate, the boot having a sole with a heel portion and a front portion, the sole being connected to a flexible upper, wherein the sole has a first rigid part which extends forward from said heel portion over about one half of the length of the sole,

wherein the sole has a flexible portion which extends from the front portion rearward to the first rigid part so as to allow the foot to flex during walking, and

wherein the first rigid part includes an interlocking surface means which interlocks with a binding of an alpine ski or in-line roller skate thus firmly fixing the first rigid part against flexing with respect to the flexible portion.

2. (Amended) The ski boot as claimed in claim 1, wherein the interlocking surface means allows for an automatic release binding to be coupled therewith.

3. (Amended) The boot as claimed in claim 1, wherein a second rigid part extends upward from said first rigid part and encloses a heel of the wearer.

5. (Amended) The boot as claimed in claim 3, wherein the interlocking surface means has at least one cutout which engages the alpine ski or skate binding.

8. (Amended) The boot as claimed in claim 1, wherein the interlocking surface means has a profiled part of standard length which engages a ski or skate binding irrespective of the boot size.

9. (Amended) The boot as claimed in claim 1, wherein the first rigid part comprises at least part of the interlocking surface.

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